

### **REMARKS**

Claims 2-5, 8-10, 22, 29-31, and 34-37 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application Publication 20030100752 published May 29, 2003 in the name of Robinson (hereinafter "Robinson"), in view of Drummond *Control of Heme Metabolism by Synthetic Metalloporphyrins*, Annals of New York Academy of Sciences, 1987, 514, 87-95 (hereinafter "Drummond") and Bettelheim *et al.*, (General, Organic and Biochemistry, 1998, page 596 (hereinafter *Bettelheim*)).

Claims 11-28 and 31 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent 5,275,801 issued January 4, 1994 to Niedballa *et al.* (hereinafter "Niedballa").

Claims 11 – 31 are hereby canceled without prejudice. Such cancellation is not an admission that any of such claims were properly rejected in the Office Action hereby responded to.

New dependent claims 38 - 48 are hereby added, and the remaining rejections are hereby traversed.

**I. The Claims are not obvious over Robinson in view of Drummond and Bettelheim.**

In order to clarify applicant's position, the following is a summary of such position:

1. Tin mesoporphyrin is a known compound; however, it is not water-soluble.
2. An aspect of applicant's invention is to render tin mesoporphyrin water-soluble by complexing such compound with an amino acid.
3. The prior art relied on by the Examiner does not teach or render obvious that tin mesoporphyrin should be complexed with an amino acid and that such a complex would render the insoluble tin mesoporphyrin water-soluble.

To the extent that the Examiner relies on Robinson as disclosing tin mesoporphyrin, although applicant disagrees, such issue is not pertinent in that Applicant has not asserted that tin mesoporphyrin was not known in the art.

The issue presented is not whether Robinson or some other prior art reference is relied upon to demonstrate that tin mesoporphyrin was known in the art. Instead, the issue is whether the art teaches one skilled in the art that the water-insoluble tin mesoporphyrin *should* be complexed with an amino acid and that such complexing *would* impart water-solubility to tin mesoporphyrin.

However, even if Robinson does disclose a tin mesoporphyrin (which it does not), Robinson does not disclose or suggest such compound *should* be complexed with an amino acid and/or that such a complex *would* be water-soluble, even though the uncomplexed compound is not water-soluble.

With regard to Drummond, Applicant fails to see the pertinence of this reference to the instant claims. Drummond does not disclose a tin mesoporphyrin and does not disclose or suggest that such compound *should* be complexed with an amino acid, or that the resulting complex *would* be water-soluble, even though tin mesoporphyrin is not water-soluble.

With regard to Bettelheim, at best, Bettelheim discloses that *some* amino acids are water-soluble. However, such disclosure does not suggest or render obvious Applicants' invention: tin mesoporphyrin (which is itself not water-soluble) *when* complexed *with* an amino acid *is* water-soluble. The water-solubility *vel non* of any *given* amino acid (or of amino acids *generally*) is by no means a teaching or suggestion that the *complexing* of such an amino acid (or of amino acids *generally*) *with* tin mesoporphyrin would impart *solubility* to the insoluble tin mesoporphyrin.

The artisan would *only* appreciate those possibilities, and be guided to the instant claims,

by considering the data and the teachings disclosed by the *instant* specification (*i.e.*, the *actually* reduced to practice fact of the esrtwhile insoluble tin mesoporphyrin *being made soluble* by Applicants' complexing of it with amino acids).

Accordingly, with regard to Bettelheim the instant rejection is a textbook example of hindsight reconstruction, masquerading behind a reference that does not stand for the proposition for which it is asserted (*i.e.*, anything complexed to an amino acid will be water-soluble and / or that tin mesoporphyrin complexed to an amino acid will be water-soluble).

In the absence of a teaching or suggestion in the art that tin mesoporphyrin *should* be complexed with an amino acid and that such a complex *is* water-soluble, even though the uncomplexed compound is not, the claims are patentable over a combination of Robinson, Drummond, and Bettelheim.

In light of the foregoing, Applicants submit that independent claims 2, 5, and 34 are nonobvious in view of the cited references. The remaining claims, each of which depends from claims 2, 5, or 34 are each directed to further elements of the invention in combination with those of claims 2, 5, or 34 and are therefore also patentable over the references. Applicants further submit that the application is in condition for allowance, and they therefore request its prompt passage thereto.

It is believed that no further fee is due. However, if any further fee is due it should be charged to Deposit Account No.: 03-0678. Similarly, any credit for overpayment should be credited to Deposit Account No.: 03-0678.

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**CERTIFICATE OF MAILING**

Deposit Date: March 26, 2009

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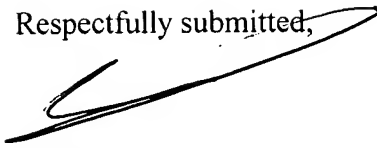
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3/26/09

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Respectfully submitted,

  
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